

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Valley Dental, Inc.

Serial No. 74/651,841

Paul Grandinetti of Levy, Zito & Grandinetti for Valley
Dental, Inc.

Dominic J. Salemi, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before **Cissel**, Seeherman and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

The above-identified application was filed on March 27,
1995, seeking registration on the Principal Register of the
mark "SAMMY CENTRAL" as a service mark for "promoting dental
services and dental health," in Class 42. Applicant claimed
first use and use in interstate commerce since January 4,
1988, and stated that the mark is used "by printing it on
signs, brochures, booklets, letterhead, labels, bulk mail,
novelty items, and custom printed products[,] by
broadcasting on radio and television, and by other ways

Ser No. 74/651,841

customary in the trade." The application included as specimens photocopies of the sheet shown below.

The Examining Attorney found the specimens to be unacceptable as evidence of service mark use of the term sought to be registered because they contain "no reference to a service." The Examining Attorney cited Trademark Rule 2.58 and required specimens which showed the term sought to be registered used to identify the services set forth in the application. Additionally, amendment to the recitation of services was required because the original recitation was found to be indefinite.

Applicant responded by amending the recitation of services to restate them as "promoting dental services and dental health through informative promotions," and offered the following explanation of how the mark is used in connection with applicant's services: "The applicant promotes its dental services and dental health through informative promotional material that is oriented to children. The promotions are signs, brochures, and advertisements and include characters in stories and/or cartoons that promote good dental practices."

Submitted with this explanation were eighteen declarations from applicant's customers. In each, the declarant avers that he or she is familiar with applicant's advertisements for its services of promoting dental health and dental services, as well as a number of the marks applicant seeks to register. Each declarant further asserts

that he or she has come to associate the services provided by applicant with the specified marks, including the mark "SAMMY CENTRAL."

The Examining Attorney made the requirement for substitute specimens final with the second Office Action. Applicant was again advised that the specimens of record were "unacceptable as evidence of actual service mark use because they contain no reference to a service." Trademark Rule 2.58 was again cited as the basis for the requirement for substitute specimens. Again the Examining Attorney required amendment to the recitation of services because the existing one was found to be indefinite. He suggested adoption of "promoting dental services and dental health through personal visits by a costumed character."

On December 20, 1996, applicant appealed. Submitted with the notice of appeal was an amendment to the recitation of services. The application was amended to specify the services as "promoting dental health to children."

Also included were substitute specimens, supported by a proper declaration as to use at least as early as the filing date of the application. The specimens are copies of pages from a promotional brochure which applicant states is given to children as part of the service of promoting dental health. One page shows a tooth-shaped cartoon character labeled "MYRTLE MOLAR" holding a membership card for the

"Tooth Tots Club," which is identified as being "for kids age 2-12." Other tooth characters are shown on the second page of the brochure. Six are shown on the third page, entreating the reader to join the club, get a free "fun pack," and a free examination. Each page of the promotional brochure prominently features applicant's name, "VALLEY DENTAL." The final page appears to be the cover of the mailer for the "Tooth Tots Club." It features the words "VALLEY DENTAL" and "Tooth Tots Club," as well as the images of the five tooth-shaped cartoon characters which are shown in the original specimens, including the one labeled with the mark sought to be registered.

On February 13, 1997, the Board instituted the appeal, and then suspended action on it and remanded the application to the Examining Attorney for consideration of the amendment and the substitute specimens.

The record does not reflect action on the remanded application by the Examining Attorney, however. Applicant filed its brief on February 18, 1997. The Examining Attorney's undated responsive brief was subsequently entered into the record, and applicant filed a reply brief, but did not request an oral hearing. Because the Examining Attorney's brief appears to take into account the amended recitation of services and the additional specimens, we are considering this appeal now as if the Examining Attorney had

timely responded to the Board's remand order by reconsidering the application and then maintaining the requirements for new specimens and an amended recitation of services.

Based on careful consideration of the record in this application, as well as the pertinent legal authorities, we hold that the requirements for different specimens and an amendment to the recitation of services are unnecessary. This application is in condition for publication. The specimens applicant has submitted are acceptable evidence of applicant's use of the term it seeks to register as a service mark for the services set forth in the application, as amended, and that amended recitation of services is not unacceptably indefinite.

We note for the record that we are disregarding the language in the Examining Attorney's brief relating to the previously unmentioned "refusal to register the character name 'SAMMY CENTRAL' under Sections 2, 3, and 45 of the Trademark Act on the ground that the aforesaid character name does not function as a trademark." We are interpreting his words concerning those sections as simply another perspective on the issue that was raised by the Examining Attorney in every Office Action and his brief, and which was argued by applicant in every response and in its appeal brief, i.e., whether the specimens show the mark sought to

be registered used to identify the services set forth in the application, as amended.

At the outset of our discussion of the merits of this appeal, we should address the issue of the requirement for a more definite recitation of applicant's services. As amended, the services are specified as "promoting dental health to children." We fail to see anything indefinite about this wording. The service, i.e., the activity performed for the benefit of others, is plainly stated as promoting dental health. Applicant goes on to state that this service is rendered to children, although that aspect of the service is not as significant as the promotional activity itself. "Promoting dental health to children," or even just "promoting dental health," is a definite statement specifically identifying the service applicant renders. It is unnecessary to specify the means by which this is accomplished. In any event, we can see no legal, logical, or evidentiary basis for the Examining Attorney's repeated suggestion that applicant promotes dental health "through personal visits by a costumed character." It eludes us why promotion through a costumed character would be acceptable, but promotion through the use of cartoon characters apparently would not be.

In summary, the existing recitation of services is specific and definite enough. We note for the record that

if applicant were only promoting its own services under the mark, registration as a service mark for these promotional services would not be proper because it is not a service to promote one's own services. This is apparently not the case, however. Applicant promotes dental health to children in general, rather than its own services in particular. In any event, the Examining Attorney has never refused registration on the basis that what applicant does under the mark is not a service because applicant is only promoting its own services.

As indicated above, we find that the specimens do show that applicant uses "SAMMY CENTRAL" as a service mark for applicant's services of promoting dental health to children. The Examining Attorney argues that the specimens of record are unacceptable because they do not specifically mention the promotion of dental health. The mere fact that the specimens of record do not specifically state that applicant offers "SAMMY CENTRAL brand services of promoting dental health to children," however, does not disqualify the specimens.

Section 1 of the Lanham Act provides for the registration of marks used in commerce to identify services, and paragraph (A)(1)(C) of that section requires that specimens or facsimiles of a mark as used must be submitted along with the application, drawing and fee. The Court of

Customs and Patent Appeals, in *In re Universal Oil Products Company*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973), discussed the requirement of Section 45 of the Act that in order for a mark to be registered as a service mark, it must be used in the sale or advertising of services. In his opinion in that case, Judge Rich, citing *Ex Parte Phillips Petroleum Co.*, 100 USPQ 25 (Com'r Pats. 1953), noted that the specimens in an application must show a "direct association" between the offer of services and the mark sought to be registered.

An example of how this standard can be met is provided in the more recent case of *In re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987). There, the Court took into account the specimens of record, as well as affidavits from purchasers of applicant's services stating that they considered the mark sought to be registered to identify the services specified in the application. The Court concluded that the specimens submitted with the application showed the mark used to identify the services named in the application.

The situation in the case now before us is clearly analogous to that one. Here, the specimens show the mark sought to be registered used in materials which applicant provides to children as part of the service of promoting dental health to them. The cartoon character labeled "SAMMY CENTRAL" appears in ways obviously intended to create in a

child's mind a friendly and inviting image for having dental health maintained through the use of dental professionals like applicant. The "Tooth Tots Club" mailer shows the "SAMMY CENTRAL" character smiling as he waves at the reader. "VALLEY DENTAL" is printed on each page of the brochure, in which children are encouraged to join the club in order to receive "Free Gifts, Free Games, and unlimited FUN!" Applicant has explained that these materials are distributed to children in connection with the service of promoting dental health. Moreover, in addition to being performed for children at applicant's dental clinics, these services are provided without charge at educational and other institutions. Applicant has shown that the materials are used as part of its program to promote dental health to children. The direct association in the mind of a child receiving this informational material between "SAMMY CENTRAL" and the advantages of good dental health is plainly established.

Further, just as in the Marketing Development Inc. case, supra, not only are we presented with these unambiguous examples of the use of the mark in the kinds of ways such a mark would be used in connection with the specified services, we also have statements from a number of the purchasers of the services that they have come to associate the services of applicant with the mark. While

this would not be persuasive evidence without specimens which show the mark used in connection with the specified service, this evidence confirms what the specimens establish, that applicant uses the mark in ways that create a direct association in the minds of purchasers between the mark and the services.

In summary, the recitation of services in this application, as amended, is sufficiently definite, and the specimens of record show the mark sought to be registered used in connection with the rendering of the specified services.

Accordingly, the requirements for additional specimens and amendment to the recitation of services are reversed, and the application will proceed to publication.

R. F. Cissel

E. J. Seeherman

E. W. Hanak
Administrative Trademark Judges
Trademark Trial & Appeal Board